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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/901,692	07/28/97	KAMAKURA	A	1095.1076/JD

LM02/0607

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EXAMINER	
KAZIMI,H	

ART UNIT	PAPER NUMBER
2765	5

DATE MAILED: 06/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/901,692	Kawasaki-Shi et al.
Examiner	**Group Art Unit**
Hani Kazimi	2765

☒ Responsive to communication(s) filed on *March 25, 1999.*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-14* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-14* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. This communication is responsive to the amendment filed on March 25, 1999.

Status of Claims

2. Of the original Claims 1-10, claims 1, and 2 have been amended by Applicants' amendment filed on March 25, 1999. The same amendment has added claims 11-14. Therefore, claims 1-14 are under prosecution in this application.

Summary of this Office Action

3. Applicants' arguments filed on March 25, 1999 have been fully considered, and discussed in the next section below or within the following rejection under 35 U.S.C. § 103 are not deemed to be persuasive, and Applicants' request for allowance is respectfully denied.

Response to Applicants' Amendment

4. The Examiner acknowledges Applicants' amended title and therefore withdraws the prior office action's objection regarding this matter. Applicants' remaining traversals are discussed under the 35 U.S.C. § 103 rejection below.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

7. Claims 1, and 11-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (U.S. Patent No. 5,664,115).

Claims 1, and 11-14, Fraser teaches a marketing system for processing market information of consumers and dealers via an electronic network, comprising:

personal information registering means for registering personal information of a consumer (column 3, lines 22-25; and column 5, lines 48-54);

market information registering means for registering market information about goods which the consumer desires to purchase (column 5, lines 16-21; and column 6, lines 42-48);

posting means for extracting and posting the market information registered in said market information registering means according to genres (column 5, lines 55-60; and column 6, lines 49-53); and

personal information acquiring means for acquiring personal information of the consumer necessary for a dealer to access the consumer from said personal information registering means when the market information posted at said posting means is purchased, by the dealer (column 7, lines 1-18, and column 5, lines 36-47).

Fraser teaches that the seller's record comprises several fields including access status (column 5, lines 36-47).

Fraser fails to teach the step of determining whether prior approval by the consumer is required.

Official notice is taken that prior approval before browsing information on the network is old and well known in the art, and the access status taught by Fraser can clearly include the step of determining whether prior approval by the consumer is required.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Fraser to include the step of determining whether prior approval by the consumer is required because, it provides a secure

system, and prevents any confidential information of the consumer being supplied to other users.

8. Claims 2-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (U.S. Patent No. 5,664,115) in view of Lalonde et al. (U.S. Patent No. 5,283,731).

Claim 2, Fraser teaches that the seller's record includes a field indicative of whether the seller is approved for access to the system (column 7, lines 19-37).

Fraser fails to explicitly teach that the market information has been purchased by the dealer.

However, Lalonde teaches that the consumer is the person who registers the purchased market information (column 3, lines 42-51).

Both Fraser and Lalonde fail to teach the prior approval demand determining means for determining, based on the personal information registered in said personal information registering means, whether prior approval of the consumer is required before the dealer accesses the consumer, and access confirming means for seeking approval for the dealer's access from the consumer who registered the purchased market information, when said prior approval demand determining means judges that the prior approval is required.

Official notice is taken that prior approval and confirming access before browsing information on the network is old and well known in the art.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Fraser to include the prior approval demand determining means for determining, based on the personal information registered in said personal information registering means, whether prior approval of the consumer is required before the dealer accesses the consumer the access confirming means for seeking approval for the dealer's access from the consumer who registered the purchased market information, when said prior approval demand determining means judges that the prior approval is required, since the consumer is the person who registers the purchased market information because, it will provide a secure system, and prevents any confidential information of the consumer being supplied to other users.

Claim 3, Fraser fails to teach that the access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access.

Official notice is taken that canceling a purchase or an order based on denying access is old and well known in the art.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Fraser to include the access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access because, it greatly improves the efficiency of the system.

Claims 4, and 5, Fraser teaches the personal information registered in said personal information registering means includes a type of access to the consumer (column 5, lines 36-66); and

the type of access includes at least one of indirect or direct electronic mail, indirect or direct facsimile transmission, indirect or direct mail of material, telephone call, and visit (column 5, lines 36-66).

Claim 6, Fraser teaches the personal information registered in said personal information registering means includes pre-categorized information and format-free information (column 5,

Claim 7, Fraser teaches the accounting means for charging the dealer when the dealer has purchased the market information posted at said posting means (column 6, lines 32-40).

Claims 8-10, Fraser teaches the continuation confirming means for performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market information to be continuously posted at said posting means (column 8, lines 23-27).

Fraser fails to explicitly teach the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or market information; and

the point providing means gives the consumer an extra point if the consumer purchases goods from the dealer who has purchased the market information.

Official notice is taken that bonus points and incentives for registering personal information and purchasing goods and services is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to implement the system of Fraser to include the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or market information and when the consumer purchases goods from the dealer because, it would be an advantage to the buyer to save, and to the seller to enhance the sales.

Response to Arguments

9. Applicant's arguments filed March 25, 1999, have been fully considered but they are not persuasive. In the remarks, the applicant argues in substance that Fraser does not appear to disclose;

10. In the remarks, the applicant argues in substance that;

a) Fraser does not appear to disclose the step of seeking approval by the buyer (consumer) prior to the seller accessing the buyer information.

b) There is no motivation to make the suggested combination, there is no motivation to determine whether prior approval by the consumer is required in combination with the existing "goods and services" products disclosed in Fraser and Lalonde wt al..

In response to a);

Fraser teaches that the seller's record comprises several fields including access status (column 5, lines 36-47). Since prior approval before browsing information on the network is old and well known in the art, and the access status is taught by Fraser, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Fraser to include the step of determining whether prior approval by the consumer is required to indicate to the user whether access to the consumer has been granted or denied because, it provides a secure system, and prevents any confidential information of the consumer being supplied to other users.

In response to b);

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings of the access status in Fraser, and the prior approval before browsing information on the network, whether you are using it for accessing the buyer or the seller information still meet the "claimed invention". The cited references meet the scope of the claimed limitations.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this statement or earlier statements from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached on Monday - Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners' supervisor, Allen MacDonald, can be reached at (703) 305-9708. The fax phone number for this Group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi.

June 2, 1999

ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER